



Attorney Docket No. PFI-016CII

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Orlow *et al.*

Art Unit: 1614

Serial No.: 09/827,428

Examiner: R. Cook

Filing Date: April 6, 2001

Title: Methods and Compositions That Affect
Melanogenesis

Assistant Commissioner for Patents
Washington, DC 20231

CERTIFICATION UNDER 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, DC 20231 on the date shown below.

11/22/02
Date of signature and
of mail deposit

Jo-Ann Bergantino
Jo-Ann Bergantino

RESPONSE TO ELECTION REQUIREMENT UNDER 35 U.S.C. § 121

Hon. Assistant Commissioner for Patents:

Applicants hereby respond to the Office Action dated November 1, 2002, which detailed a Requirement for Election of Species under 35 U.S.C. § 121.

In the Office Action, the Examiner made final the Restriction Requirement of June 28, 2002, recognized Applicants' election of Group IV (claims 70-82 and 91-92) with traverse, and withdrew the remaining claims (claims 1-69 and 83-90) from consideration. The Examiner then indicated that Applicants must provisionally elect a single species disclosed in claim 73 for prosecution.

In response, Applicants provisionally elect for prosecution species (d), which is a compound of the formula (I). Of the elected claims that have not been withdrawn from consideration (claims 70-82 and 91-92), claims 70-73, 82, and 91-92 read on the provisionally elected species.

Applicants also note that certain compounds of the elected formula (I), for example, the compound of formula (VIII) at page 53, fit the definition of "hydrophobic amine" at page 58, lines 31-33 of the specification. To this extent, claim 75 is not mutually exclusive with, and could encompass certain compounds falling within, the elected formula (I).

Further and favorable consideration of all of the claims of record on the merits is respectfully requested.

No fees are believed to be due. However, if any fee is due or credit is owed, please make them to our Deposit Account No. 08-0219.

The Examiner is encouraged to telephone the undersigned at the number listed below in order to expedite the prosecution of this application.

Respectfully submitted,

Emily R. Whelan
Emily R. Whelan
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Dated: November 22, 2002

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